

Application No. 09/841,475

Atty Docket No. FATB 1000-1

**REMARKS**

Claims 1-32 and 34-54 are rejected, and claim 33 is objected to. In this paper, we cancel claims 23-26 and amend claims 1, 10-15, 27 and add claims 55-56. Claims 1-22, 27-32, and 34-56 are pending in this application, after entry of amendments.

Claims 10-15 are objected to because the term "the instant messaging buddy list" lacks antecedent basis, and have been amended to overcome the objection.

In support of the amendments to claim 1, we direct the Examiner's attention to paragraphs [0025]-[0027] and cancelled claims 10-15. New claim 55 adopts a subset of the limitations in amended claim 1.

**Claim Rejections under 35 USC 103**

**Claims 1-3 are rejected under 35 USC 103(a) as being unpatentable over Stirpe et al. (US Appln. 2002/0087496).**

**Claim 1**

**Claim 1**, as amended, includes the limitations:

*registering a user with a registration server to collect and share tracking data corresponding to at least a portion of the user's computer usage experiences, wherein the computer usage experiences include one or more of browsing URLs, downloading files or visiting a location with a computer device that records the visited location;*

*accessing one or more of the user's messaging buddy lists to identify one or more buddies with whom the tracking data may be shared;*

*defining rights of the buddies to access the tracking data;*

*tracking at least a portion of the user's computer usage experiences and reporting the tracking data to a tracking server;*

We have reviewed the cited passages in Stirpe et al. and do not find these limitations. The Examiner concedes that Stirpe et al. does not teach sharing *the user's computer usage experience*. We do not see anywhere that Stirpe et al. registers users to collect and track data corresponding to computer usage experiences, defines buddy list rights to access tracked data or tracks the user's computer usage experiences and reports the experiences

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to a server.

The Examiner argues that "*posting at least a portion of the user's tracking data for the buddies to access according to their defined rights*" could obviously be presented through Stirpe's system. It is fundamental, as indicated in MPEP § 2143.01, that the Examiner rely on some evidentiary quality suggestion to modify Stirpe et al.:

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also *In re Lee*, 277 F.3d 1338, 1342-44, 61 USPQ2d 1430, 1433-34 (Fed. Cir. 2002) (discussing the importance of relying on objective evidence and making specific factual findings with respect to the motivation to combine references); *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

This section of the MPEP cites the no-longer recent case, *In re Lee*, in which the Federal Circuit clarified the need for evidentiary quality support of an Examiner's factual basis for finding a teaching, suggestion or motivation in the prior art (as opposed to the Examiner's opinion), 277 F.3d at 1343-44:

As applied to the determination of patentability *vel non* when the issue is obviousness, "it is fundamental that rejections under 35 U.S.C. § 103 must be based on evidence comprehended by the language of that section." *In re Grasselli*, 713 F.2d 731, 739, 218 U.S.P.Q. (BNA) 769, 775 (Fed. Cir. 1983). ... "The factual inquiry whether to combine references must be thorough and searching." *Id.* It must be based on objective evidence of record. This precedent has been reinforced in myriad decisions, and cannot be dispensed with. [citation omitted] The need for specificity pervades this authority. See, e.g., *In re Kotzab*, 217 F.3d 1365, 1371, 55 U.S.P.Q.2D (BNA) 1313, 1317 (Fed. Cir. 2000) ("particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed"); *In re Rouffet*, 149 F.3d 1350, 1359, 47 U.S.P.Q.2D (BNA) 1453, 1459 (Fed. Cir. 1998) ("even when the level of skill in the art is high, the Board must identify specifically the principle, known to one of ordinary skill, that suggests the claimed combination. In other words, the Board must explain the reasons one of ordinary skill in the art would have been

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motivated to select the references and to combine them to render the claimed invention obvious."); *In re Fritch*, 972 F.2d 1260, 1265, 23U.S.P.Q.2D (BNA) 1780, 1783 (Fed. Cir. 1992) (the examiner can satisfy the burden of showing obviousness of the combination "only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references"). ... In its decision on Lee's patent application, the Board rejected the need for "any specific hint or suggestion in a particular reference" to support the combination of the Nortrup and Thunderchopper references. Omission of a relevant factor required by precedent is both legal error and arbitrary agency action.

The outcome of cases decided before *In re Lee* makes it clear that real evidence is required to support an asserted teaching, suggestion or motivation to modify a single reference for obviousness. See, e.g., *In re Kotzab*, 217 F.3d 1365, 1369-70 (Fed. Cir. 2000) (rev'd finding of obviousness, as "Even when obviousness is based on a single prior art reference, there must be a showing of a suggestion or motivation to modify the teachings of that reference."); *Kolmes v. World Fibers Corp.*, 107 F.3d 1534, 1541 (Fed. Cir. 1997) (aff'd patent not invalid, as no suggestion to modify the '989 patent with regard to non-metallic fibers).

The Examiner argues, in essence, it would be obvious to modify the teachings of *Stripe et al.* to meet the limitations of claim 1, because that would benefit users. This reasoning uses the benefits taught by this application as a template for modifying the single cited reference. There is no evidence of a suggestion in the single *Stirpe et al.* reference or of general knowledge among those of skill in the art to make the claimed modification. It is impermissible to use hindsight that is based on knowledge imparted only by this applicant's disclosure.

Therefore, claim 1 should be allowable over *Stirpe et al.*

### Claims 2-3

**Claims 2-3** include limitations describing alternate configurations of registration and tracking servers. Applicants do not find any tracking server, as that term is used in these claims, in *Stirpe et al.*

Therefore, claims 2-3 should be allowable over *Stirpe et al.*

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**Claims 1-29, 32, 34-51 and 53-54 are rejected under 35 USC 103(a) as being unpatentable over Olivier (USP 6,480,885).**

Claims 1, 19 and 27

**Claims 1, 19 and 27** include the limitations:

*1. ... registering a user with a registration server to collect and share tracking data corresponding to at least a portion of the user's computer usage experiences;*

*accessing one or more of the user's messaging buddy lists to identify one or more buddies with whom the tracking data may be shared;*

*defining rights of the buddies to access the tracking data;*

*tracking at least a portion of the user's computer usage experiences and reporting the tracking data to a tracking server;*

*19. The method of claim 1, wherein the user utilizes a computer and tracking is carried out by a module resident on the computer.*

*27. The method of claim 1, wherein the computer usage includes sending tracking data regarding one of a user's computer usage experiences to one or more buddies.*

These limitations are not found in Olivier. What Olivier teaches is a centralized interest matching service (FIG. 7) to enhance e-mail mailing lists. Applicants have not found any module resident on a user's computer or other mechanism that tracks a user's computer usage experience.

The Examiner concedes that Olivier does not teach sharing *the user's computer usage experience*. We do not see anywhere that Olivier registers users to collect and track data corresponding to computer usage experiences, defines buddy list rights to access tracked data or tracks the user's computer usage experiences and reports the experiences to a server. Tracking data is not collected by Olivier – storing and forwarding e-mail messages is not quite tracking user computer experiences or tracking data – so Olivier cannot be extended to *"posting at least a portion of the user's tracking data for the buddies*

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*to access according to their defined rights". As outlined above, there is no evidentiary quality suggestion of record to modify Olivier, as required by MPEP § 2143.01.*

Therefore, claims 1, 19 and 27 should be allowable over Olivier.

**Claims 2-3**

**Claims 2-3** include limitations describing alternate configurations of registration and tracking servers. Applicants do not find any tracking server, as that term is used in these claims, in Olivier. Neither an e-mail server or matching server appears to meet these limitations and we do not see other candidates in Olivier to be the tracking server.

Therefore, claims 2-3 should be allowable over Olivier.

**Claims 4-7**

**Claims 4-7** include the limitations:

- 4. The method of claim 1, wherein registering the user excludes collection of the user's e-mail address.*
- 5. The method of claim 1, wherein registering the user excludes collection of the user's actual name.*
- 6. The method of claim 1, wherein registering the user excludes collection of the user's physical address.*
- 7. The method of claim 1, wherein registering the user excludes collection of any information that identifies a user in a manner adapted to direct marketing.*

These limitations are contrary to Olivier. Olivier expressly teaches, in a passage cited by the Examiner, "Upon providing profile data such as name, address, email address, age, and occupation, the server stores the base user profile data record in the database." Col. 9, lines 23-26. This statement is objective evidence that Olivier does not motivate one of skill in the art to meet the limitations of claims 4-7, which exclude collecting the data that Olivier teaches one to collect. Following *In re Lee*, quoted above, and MPEP § 2143.01, the evidence does not support the Examiner's argument about what one of skill in the art would be motivated to do.

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At least some of the Examiner's proposed modifications to Olivier would impermissibly change the principle of operation for Olivier's "method for enabling users to exchange group electronic mail by establishing individual profiles and criteria, for determining personalized subsets" of email mailing lists. The whole principle of operation is to improve on methods for establishing group email lists.

MPEP § 2143.01 explains that a proposed modification cannot change the principle of operation of a reference:

**THE PROPOSED MODIFICATION CANNOT CHANGE THE PRINCIPLE OF OPERATION OF A REFERENCE**

If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959) (Claims were directed to an oil seal comprising a bore engaging portion with outwardly biased resilient spring fingers inserted in a resilient sealing member. The primary reference relied upon in a rejection based on a combination of references disclosed an oil seal wherein the bore engaging portion was reinforced by a cylindrical sheet metal casing. Patentee taught the device required rigidity for operation, whereas the claimed invention required resiliency. The court reversed the rejection holding the "suggested combination of references would require a substantial reconstruction and redesign of the elements shown in [the primary reference] as well as a change in the basic principle under which the [primary reference] construction was designed to operate." 270 F.2d at 813, 123 USPQ at 352.).

*Accord, Zygo Corp. v. Wyko Corp.*, 79 F.3d 1563, 1569, 38 U.S.P.Q.2D (BNA) 1281 (Fed. Cir. 1996) (equivalence to redesign reversed, as principles of operation obviously not the same); *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 1052, 5 U.S.P.Q.2D (BNA) 1434 (Fed. Cir. 1988) (invalidity reversed, as principles of operation antithetical and no teaching or suggestion to combine). Modifying Olivier enough to meet these limitations (e.g., not collecting email addresses for an email system) would change the principle of operation of Olivier's system. It would also violate the corollary rule that the proposed modification must not render the reference unsuitable for its intended purpose. "A proposed modification should not 'destroy a reference' by rendering the prior art invention being modified unsatisfactory for its intended purpose. *In re Gordon*, 733 F.2d 900, 902,

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221 USPQ 1125, 1 127 (Fed. Cir. 1984).” Barry R.A. Weinhardt, M. Reinhart, Obviousness Under 35 U.S.C. 103 Basic Student's Manual, p. 24 (U.S. P.T.O. Office of Patent Policy Dissemination, Rev. 4 1998); explaining, M.P.E.P. 2143.01 and 2145, paragraph (j)(4). Without email addresses, for instance, an email system cannot operate.

Therefore, claims 4-7 should be allowable over Olivier.

**Claims 8-9**

**Claims 8-9** include the limitations:

*8. The method of claim 1, wherein registering the user further includes establishing an anonymous unique identifier for the user.*

*9. The method of claim 8, wherein reporting the tracking data includes reporting the anonymous unique identifier.*

Again, the limitation of claim 8 is directly contrary to the teaching of Olivier, col. 9, lines 23-26. And, Applicants do not find in the reference reporting of tracking data to a tracking server using an anonymous identifier.

Therefore, claims 8-9 should be allowable over Olivier.

**Claims 10-15**

**Claims 10-15** include the limitations as to compatibility with instant messaging systems. The organizing principle of Olivier is to have a matching server decide with whom a user will communicate. As explained in the specification of this application [0035], these instant messaging systems build buddy lists by mutual agreement of the users (reciprocal inclusion on buddy lists), which is the opposite of Olivier's organizing principle. Limiting Olivier to use the mutual agreement / reciprocal inclusion protocols of these instant messaging products would violate both of the principles that a modification cannot change the principle of operation or render a reference unsuitable for its stated purpose.

Therefore, claims 10-15 should be allowable over Olivier.

**Application No. 09/841,475****Atty Docket No. FATB 1000-1****Claims 16-18****Claims 16-18** include the limitations:

*16. The method of claim 1, wherein the rights of the buddies are defined by content category of the user's computer usage.*

*17. The method of claim 1, wherein the rights of the buddies are defined by appearance of one or more keywords on pages corresponding to URLs viewed.*

*18. The method of claim 1, wherein the rights of the buddies are defined by activity type of the user's computer usage.*

The Examiner concedes that these limitations are not found in Olivier. Defining a special group forum from preference profiles as the Examiner suggests would not meet these limitations. It would not meet the rights definition by content category of tracked computer usage limitation, or the keywords on pages viewed limitation or activity type of tracked computer usage limitation. Preference profiles do not satisfy these limitations.

Therefore, claims 16-18 should be allowable over Olivier.

**Claim 20****Claim 20** include the limitations:

*20. The method of claim 1, wherein the tracking is carried out by a device placed between a computer utilized by the user and an access point to the Internet.*

Applicants challenge the Examiner's statement of what is well-known, because it is imprecise and does not meet the claim limitations. The Examiner says that proxy servers that track information exchanges are well-known, but this does not meet the claim limitations. To this author's experience, the tracking function of proxy servers is a system-owner spying and policing function, not a sharing with your buddies function.

Applicants take this opportunity, under MPEP § 2144.03, to require the Examiner to present evidence such as a publication or an affidavit, rather than the Examiner's assertion, so Applicants can see what this purportedly well-known proxy server actually does. The recent case on point is non-precedential, but we have learned from seminars by PTO personnel that the PTO considers non-precedential decisions when it formulates internal policy, so we offer it for its persuasive reasoning. *In re Bruce Beasley*, Serial No.



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07/636,839, Docket 04-1225 (Fed. Cir. Dec. 7, 2004), the Federal Circuit reversed the PTO Examiner and the Board of Patent Appeals because the Examiner's personal opinion as to what was "well-known" was unsupported by any substantial evidence and was not, by itself, evidence. The Federal Circuit quoted extensively from the MPEP:

The MPEP provides guidelines for relying on official notice and personal knowledge, which the examiner did not follow in this case:

The rationale supporting an obviousness rejection may be based on common knowledge in the art or "well-known" prior art. The examiner may take official notice of facts outside of the record which are capable of instant and unquestionable demonstration as being "well-known" in the art. *In re Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970) . . . . .

When a rejection is based on facts within the personal knowledge of the examiner, the data should be stated as specifically as possible, and the facts must be supported, when called for by the applicant, by an affidavit from the examiner. Such an affidavit is subject to contradiction or explanation by the affidavits of the applicant and other persons. See 37 CFR 1.104(d)(2). . . . For further views on official notice, see *In re Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418, 420-421 (CCPA 1970) ("Assertions of technical facts in areas of esoteric technology must always be supported by citation of some reference work" and "allegations concerning specific 'knowledge' of the prior art, which might be peculiar to a particular art should also be supported." . . .

MPEP § 2144.03 (7th ed. 1998) (emphases added [in Federal Circuit's opinion]); see also MPEP § 2144.03 (7th ed., rev. 1, 2000).

Slip. Op., at 9-10. The appellate court held that "the statements made by the Examiner, upon which the Board relied, amount to no more than conclusory statements of generalized advantages and convenient assumptions about skilled artisans." *Id.* at 10. From the MPEP and this recent non-precedential decision, it should be apparent that the Examiner needs more than an unsupported statement, not even aligned with the claim limitations, about how a proxy server would be combined with Olivier.

Therefore, claims 20 and 23 should be allowable over Olivier.

#### Claims 21-22

**Claims 21-22** include alternatives for filtering information processed by a tracking server. As described above, there is no tracking server in Olivier. Assuming contrary to

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reason that an email server could be a tracking server, claim 21 is allowable because email messages are not filtered before they are reported to the email server.

Therefore, claims 21-22 should be allowable over Olivier.

(Claims 23-26 have been cancelled.)

**Claims 28-29**

**Claims 28-29** include the limitations of categorizing tracking data by content and sorting or searching it. The Examiner concedes that these limitations are not taught by Olivier. Not every database analysis technology would be obviously applied to Olivier.

Applicants take this opportunity, under MPEP § 2144.03, to require the Examiner to present evidence such as a publication or an affidavit, rather than the Examiner's assertion, as to the motivation to apply claimed data analysis technologies to Olivier's data structures.

In the absence of evidentiary proof, claims 28-29 should be allowable over Olivier. Moreover, there is no tracking server in Olivier.

**Claim 32**

**Claim 32** includes the limitations, "*wherein posting further includes indexing text portions of at least a portion of pages reported from tracking the user's Internet usage.*" The limitations of tracking a user's Internet usage, reporting internet usage to a tracking server, and indexing pages (e.g., after retrieving the same URLs) reported to the tracking server are not found in Olivier, particularly col. 3, lines 23-32.

Therefore, claim 32 should be allowable over Olivier.

**Claims 34-51 and 53-54**

Claims 34-51 and 53-54 are rejected by referring to grounds of rejection that have been answered above. Therefore, claims 34-51 and 53-54 should be allowable over Olivier.

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**Claims 30-31 and 52 are rejected under 35 USC 103(a) as being unpatentable over Olivier as applied to claims 1-29, 32, 34-51 and 53-54, further in view of Stirpe et al.**

**Claims 30-31**

**Claims 30-31 include the limitations:**

*30. The method of claim 1, wherein posting further includes providing annotation tools for associating notes with individual tracking data entries.*

*31. The method of claim 1, wherein posting further includes providing annotation tools for associating ratings with individual tracking data entries.*

The Examiner concedes that these limitations are not found in Olivier. However, the Examiner proposes combining annotation facilities of Stirpe et al. with Olivier's automatic mailing list matching. The proposed combination would not meet the limitations, because there are no individual tracking data entries in Olivier (the matching patent) to annotate, note or rate. Nor is there any evidence of a suggestion or motivation to combine a trainer's behavior with an automated, no-trainer-involved, profile matching system.

Therefore, claims 30-31 should be allowable over Olivier as applied above further in view of Stirpe et al.

**Claim 52**

**Claim 52** includes the same limitations as claim 31 and should be allowable over Olivier as applied above further in view of Stirpe et al. for the same reasons.

**CONCLUSION**

Applicants respectfully submit that the claims, as stated herein, are in condition for allowance and solicit acceptance of the claims, in light of these remarks. If the Examiner disagrees and sees amendments that might facilitate allowance of the claims, a call to the undersigned would be appreciated.

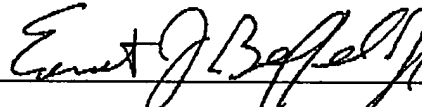
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Should any questions arise, the undersigned can ordinarily be reached at his office at 650-712-0340 from 8:30 to 5:30 PST, M-F and can be reached at his cell phone 415-902-6112 most other times.

Respectfully submitted,

Dated: 10 February 2005



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